

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-67 are presently active in this case.

The outstanding Office Action rejected Claims 1-2, 4-8, 11-27, 31-46, 54, 57-65 and 67 under 35 U.S.C. § 102(b) as being anticipated by Casscells et al. (U.S. Patent No. 6,615,071). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Casscells et al. in view of Tiernan et al. (U.S. Patent No. 6,150,809). Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Casscells et al. in view of Hedengren et al. (U.S. Patent No. 6,180,867).

In response to the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. §103(a), Applicant respectfully requests reconsideration of these rejections and traverses the rejections as discussed next.

Independent Claim 1 recites: "A method of acquiring an image comprising ...utilizing said at least one non-optical sensor to acquire an image of one of a non-dermatoglyphic zone of skin and a zone of hair."

Independent Claim 31 recites: "*A method for recommending cosmetic treatment*, the method comprising:

a) acquiring an image of at least one of a non-dermatoglyphic zone of the skin and a zone of the hair utilizing a non-optical sensor."

Independent Claim 36 recites: "A method of acquiring an image comprising ... utilizing said at least one non-optical sensor to acquire an image of one of a non-dermatoglyphic zone of skin and a zone of hair."

Independent Claim 37 recites: "A method of acquiring an image comprising ... utilizing said at least one non-optical sensor to acquire an image of one of a non-dermatoglyphic zone of skin and a zone of hair."

Independent Claim 57 recites: "A method of acquiring an image comprising ... utilizing said at least one non-optical sensor to acquire an image of one of a non-dermatoglyphic zone of skin."

Independent Claim 67 recites: "A method of acquiring an image comprising ... utilizing said at least one non-optical sensor to acquire an image of a non-dermatoglyphic zone of skin."

Turning now to the applied prior art, the Casscells et al. patent discloses a method and apparatus for detecting vulnerable atherosclerotic plaque, by identifying a region of elevated temperature along a living vessel wall.¹ However, the Casscells et al. patent fails to teach acquiring an image of one of a non-dermatoglyphic zone of skin and a zone of hair. Identifying a region of elevated temperature *along a living vessel wall* is not the same as acquiring an image of a non-dermatoglyphic *zone of skin or a zone of hair*. Therefore, the prior art fails to teach or suggest every feature recited in Applicant's claims, so that Claims 1-2, 4-8, 11-27, 31-46, 54, 57-65 and 67 are not anticipated by the prior art.² Accordingly, Applicant respectfully traverses, and requests reconsideration of, the 35 U.S.C. § 102(b) rejection based on the Casscells et al. patent.

Applicant further respectfully traverses the outstanding rejections based on the Casscells et al. patent because there is no evidence that a person of ordinary skill in the art

¹ See the Casscells et al. patent, for example the abstract and at column 1, lines 23-29.

² See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

would be motivated to modify the Casscells et al. method to arrive at Applicant's method.³

The Casscells et al. patent is not concerned with imaging skin or hair. Instead, the Casscells et al. patent is concerned with the mortality related to coronary atherosclerosis, and

cardiovascular disease. As such, the Casscells et al. method is designed to detect vulnerable atherosclerotic plaque, or plaque at risk of reducing blood flow in a vessel. The Casscells et

al. patent states that its method already achieves the goal of providing a sensitive way of identifying vulnerable or at-risk atherosclerotic plaque in a vessel, and thus of assisting the physician in diagnosing plaques at imminent risk of rupturing or occluding so that

appropriate interventional steps may be taken to avert a possibly fatal cardiovascular event.⁴

The Casscells et al. patent does not suggest that further improvement is desired, nor that another feature should be added to further improve the detection of atherosclerotic plaque. In particular, the Casscells et al. patent does not suggest to acquire an image of a non-

dermatoglyphic *zone of skin or a zone of hair*. Therefore, the Casscells et al. patent does not suggest to a person of ordinary skill in the art to modify the Casscells et al. method to arrive at Applicant's method.

The secondary references, i.e., the Tiernan et al. and Hedengren et al. patents, do not provide such motivation either. Nothing in the record indicates that images of a non-dermatoglyphic zone of skin or a zone of hair would be useful in detecting vulnerable atherosclerotic plaque. The prior art, therefore, does not provide the motivation to modify the Casscells et al. method to arrive at Applicant's claimed method. The position that the

³ See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

⁴ See Casscells et al. patent, for example, at column 5, lines 32-44.

Casscells et al. method *could be* modified to arrive at the claimed method would be insufficient to establish a *prima facie* case of obviousness.⁵ Furthermore, such modification would require a substantial redesign of the Casscells et al. method, and/or would change the basic principle of operation of the Casscells et al. method. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.⁶ In addition, the Casscells et al. patent is non-analogous to Applicants' invention⁷ because the Casscells et al. patent 1) is not in the field of Applicant's endeavor and 2) is not reasonably pertinent to the particular problem with which the Applicant was concerned.⁸

Consequently, in view of the present response, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance is earnestly solicited.

⁵See MPEP 2143.01 stating that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness"; see also same section stating "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so,'" (citation omitted).

⁶ See In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

⁷ See MPEP 2141.01(a) stating that the "examiner must determine what is 'analogous prior art' for the purpose of analyzing the obviousness of the subject matter at issue."

⁸ See MPEP 2141.01(a), quoting In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992): "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."

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Reply to Office Action of July 27, 2004

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

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